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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/653,037

08/29/2003

Frank W. Barresi

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EXAMINER

MAIER, LEIGH C

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/653,037

**Applicant(s)**

BARRESI ET AL.

**Examiner**

Leigh C. Maier

**Art Unit**

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 109-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 109-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Prosecution***

The terminal disclaimer filed July 6, 2005, is sufficient to overcome the obvious-type double patenting rejection over US 6,613,898.

### ***Double Patenting***

Claims 109 and 118 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,380,379. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reference method is a two-step process wherein the first step comprises catalytically hydrogenating a plurality of malto-oligosaccharides while preserving the DP profile of the mixture. The reference is silent regarding the DP 1-8 profile, per se, but preserving the profile in general would inherently preserve this specific range. The reference process would thereby anticipate the instant claims.

Claims 109-125 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,610,672. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reference process is a method of preserving material that comprises catalytically hydrogenating a plurality of malto-oligosaccharides while preserving the DP profile of the mixture. The reference is silent regarding the DP 1-8 profile, per se, but preserving the profile in general would

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inherently preserve this specific range. The reference process would thereby anticipate instant claims 109 and 118. The claim is silent regarding the particular conditions recited in claims 110-117 and 119-125. However, it would be obvious for one having ordinary skill in the art to look to the written description of the method, including the examples for hydrogenation conditions. Example 2 discloses a process using a Raney nickel catalyst at 120 deg at 500 psi. The example is silent regarding pH, but it would appear that a solution as prepared in the example would have a pH falling within the recited range. Furthermore, it would be obvious for one of ordinary skill to optimize this result effective variable with routine experimentation.

Claims 109 and 118 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,720,418. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reference method is a two-step process wherein the first step comprises catalytically hydrogenating a plurality of malto-oligosaccharides while preserving the DP profile of the mixture. The reference is silent regarding the DP 1-8 profile, per se, but preserving the profile in general would inherently preserve this specific range. The reference process would thereby anticipate the instant claims.

Claims 109-128 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,919,446. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reference method of claim 1 is a process for catalytically hydrogenating a plurality of malto-

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oligosaccharides while preserving the DP profile of the mixture. The reference is silent regarding the DP 1-8 profile, per se, but preserving the profile in general would inherently preserve this specific range. Dependent claims recite various reaction conditions that overlap in ranges with the particular conditions recited in claims 110-117 and 119-125. However, it would be obvious for one having ordinary skill in the art to look to the written description of the method, including the examples for hydrogenation conditions. See examples 1-3. Furthermore, it would be obvious for one of ordinary skill to optimize this result effective variable with routine experimentation.

Regarding reference claim 15, this claim is drawn to a method of hydrolyzing starch to a plurality of malto-oligosaccharides, which is followed by the step of catalytically hydrogenating said plurality of malto-oligosaccharides while preserving the DP 1-8 profile of the mixture. Instant claim 126 is anticipated by this method. Claims 127 and 128 would be obvious to one of ordinary skill based on the written description, particularly examples 1-3, as discussed above.

Claims 109 and 118 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,091,335. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reference method is a two-step process wherein the first step comprises catalytically hydrogenating a plurality of malto-oligosaccharides while preserving the DP 1-8 profile of the mixture. The reference process would thereby anticipate the instant claims.

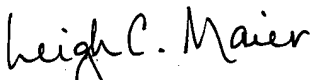
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***Examiner's hours, phone & fax numbers***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Maier whose telephone number is (571) 272-0656. The examiner can normally be reached on Tuesday, Thursday, and Friday 7:00 to 3:30 (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Anna Jiang (571) 272-0627, may be contacted. The fax number for Group 1600, Art Unit 1623 is (571) 273-8300.

Visit the U.S. PTO's site on the World Wide Web at <http://www.uspto.gov>. This site contains lots of valuable information including the latest PTO fees, downloadable forms, basic search capabilities and much more. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov> Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



Leigh C. Maier  
Primary Examiner  
November 20, 2006